

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 48 and 49 have been canceled without prejudice or disclaimer, and claims 24, 25, and 50. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-47, and 50 are pending and under consideration.

DOUBLE PATENTING REJECTIONS:

In the Office Action, at page 7, the Examiner rejected claims 1-16, 24-36, and 48-50 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. 6,735,976 (hereinafter Lee). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 7, the Examiner rejected claims 17-23 and 37-47 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Lee, in view of Montes (U.S. 6,122,897 – hereinafter Montes). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Applicants respectfully submit that the concurrently and timely filed Terminal Disclaimer overcomes the double patenting rejections.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 2, the Examiner rejected claims 1, 2, 10, 24, and 48 under 35 U.S.C. §102(b) as being anticipated by Constantini et al. (U.S. 3,178,902 - hereinafter Constantini 902). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 2, the Examiner rejected claims 1, 2, 10, 24, and 48 under 35 U.S.C. §102(b) as being anticipated by Bauman et al (U.S. 6,070,424 – hereinafter Bauman). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 2, the Examiner rejected claims 1, 2, 3, 10, 24, and 48 under 35 U.S.C. §102(b) as being anticipated by Maynard (U.S. 3,712,078 – hereinafter Maynard).

The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 3, the Examiner rejected claims 1, 2, 10, 11, 24, 48, and 49 under 35 U.S.C. §102(b) as being anticipated by Gidseg (U.S. 4,776,182 – hereinafter Gidseg). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claims 48 and 49 have been cancelled.

The MPEP states: “[t]o anticipate a claim, the reference must teach every element of the claim.” (MPEP 2131).

The MPEP then quotes: “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (Quoted in MPEP 2131).

The MPEP further quotes “[t]he elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.” *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). (Quoted in MPEP 2131).

Independent claim 1 recites: “...a top projection part formed by projecting a rear portion of a top of the cabinet upward, the top projection part defining an air cooling chamber therein such that the air cooling chamber extends upward from an upper portion of the storage compartment....”

And amended, independent claim 24 recites: “...an air cooling chamber located at an upper rear portion, upwardly projected from a rear portion of the storage compartment, and communicating with the storage compartment....”

Constantini 902 discloses a refrigerator that has a roll around refrigerator cabinet 22, that is separable from the refrigerating housing. Thus, Constantini 902 neither discloses nor suggests that compartment 47 is an upward projected portion of roll around refrigerator cabinet 22, as asserted by the Examiner. (See Constantini 902, at FIGS. 1, and 9, and col. 257 to col. 3, line 59).

Bauman discloses a refrigerator with a refrigeration unit 10 mounted on top of a cabinet 12. The refrigeration unit 10 comprises a housing 20 (including a base 22 and a cover 70) and a cooling system 100. The function of the housing 20 is to provide a unitary structure to support all of the components of the cooling system 100. (See Bauman, at FIGS. 1 and 2, and col. 3,

lines 33-47). Bauman neither discloses nor suggests that housing 20 is an upward projected portion of cabinet 12.

Maynard discloses a refrigerating unit 10 that is wholly removable and used interchangeably with chest type refrigerator cabinet 12 or a front opening type refrigerator cabinet 14. Heat exchanger 20 is disposed wholly within refrigerating unit 10, and since refrigerating unit 10 is removable, contrary to the Examiner's assertion, Maynard neither discloses nor suggests an air cooling chamber that is an upward projected portion of either the refrigerated compartment of chest type refrigerator cabinet 12 or refrigerated compartment 70 of front opening type refrigerator cabinet 14. (See Maynard, at FIGS. 1, 5, and 6, and col. 2, line 31-35, and col. 3, line 53 to col. 4, line 25).

Gidseg discloses a refrigerator 1 with a refrigeration module 10 installed on top of and in connection with insulated refrigeration cabinet 12. The refrigerating module is adjacent the food storage compartment (insulated refrigeration cabinet 12), and is separated from insulated refrigeration cabinet 12 by a wall having first and second openings therein, which define passageways interconnecting the two compartments. Thus, contrary to the Examiner's assertion, Gidseg neither discloses nor suggests that the portion of the refrigeration module 10 housing the evaporator coil 32 and evaporator fan 34 is not an upward projected portion of insulated refrigeration cabinet 12. (See Gidseg, at FIGS. 1-3, and col. 1, lines 47-65, and col. 5, line 41 to col. 6, line 47).

Applicants respectfully submit that Constantini 902, Bauman, Maynard, and Gidseg fail to disclose every element of the claims, arranged as required by the claims.

Accordingly, Applicants respectfully submit that the Examiner has not provided sufficient evidence to maintain a prima facie anticipation rejection of claims.

Applicants respectfully submit that independent claims 1, and 24 patentably distinguish over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claims 2, 3, 10, and 11, which depend from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at page 3, the Examiner rejected claims 4-7 under 35 U.S.C. §103(a) as being unpatentable over any one of Maynard, Gidseg, Bauman, or Constantini 902 in view of Watanabe (EP 1,174,666 – hereinafter Watanabe). The reasons for the rejection are set forth

in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 4, the Examiner rejected claims 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over any of Maynard, Gidseg, Bauman, or Constantini 902 in view of Silva (U.S. 5,824,023 – hereinafter Silva). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 5, the Examiner rejected claims 11-19, 22, 23, 25-30, 32-41, 46, 47, 49, and 50 under 35 U.S.C. § 103(a) as being unpatentable over any one of Maynard, Gidseg, Bauman, or Constantini 902, in view of Constantini et al. (U.S. 3,122,899 – hereinafter Constantini 899). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 5, the Examiner rejected claims 20, 21, and 42-45 under 35 U.S.C. § 103(a) as being unpatentable over any one of Maynard, Gidseg, Bauman, or Constantini 902, in view of Montes. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

In the Office Action, at page 6, the Examiner rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over any one of Maynard, Gidseg, Bauman, or Constantini 902, in view of Constantini '899, and further in view of Silva. The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Claim 49 has been cancelled.

As a general matter, to establish a *prima facie* obviousness rejection, the Examiner needs to provide evidence of the existence of individual elements corresponding to the recited limitations, a motivation to combine the individual elements to create the recited invention, and a reasonable expectation of success. (See MPEP, at 2143. – “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.’ In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).”, and at 2143.03 – “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.’ In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).”).

Should the Examiner fail to provide evidence that the individual elements exist in the prior art, or that the motivation exists in the prior art or in the knowledge generally available to one of ordinary skill in the art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. (See MPEP, at 2143.03, and 2143.01).

Independent claim 12 recites: "...a top projection part formed by projecting a rear portion of a top of the cabinet upward, the top projection part defining a first air cooling chamber for the freezer compartment and a second air cooling chamber for the refrigerator compartment therein, such that the first and second air cooling chambers extend upward from upper portions of the freezer and refrigerator compartments, respectively...."

Amended, independent claim 25 recites: "...first and second air cooling chambers located at respective upper portions, upwardly projected from respective rear portions of the first and second storage compartments, and communicating respectively with the first and second storage compartments...."

And amended, independent claim 50 recites: "...a plurality of air cooling chambers located at respective upwardly projected portions of upper rear portions of the cabinet, each having an evaporator...."

As noted above in the section regarding the rejections under §102, Constantini 902 discloses a refrigerator that has a roll around refrigerator cabinet 22, that is separable from the refrigerating housing. Thus, Constantini 902 neither discloses nor suggests that compartment 47 is an upward projected portion of roll around refrigerator cabinet 22, as asserted by the Examiner. (See Constantini 902, at FIGS. 1, and 9, and col. 257 to col. 3, line 59).

Bauman discloses a refrigerator with a refrigeration unit 10 mounted on top of a cabinet 12. The refrigeration unit 10 comprises a housing 20 (including a base 22 and a cover 70) and a cooling system 100. The function of the housing 20 is to provide a unitary structure to support all of the components of the cooling system 100. (See Bauman, at FIGS. 1 and 2, and col. 3, lines 33-47). Bauman neither discloses nor suggests that housing 20 is an upward projected portion of cabinet 12.

Maynard discloses a refrigerating unit 10 that is wholly removable and used interchangeably with chest type refrigerator cabinet 12 or a front opening type refrigerator cabinet 14. Heat exchanger 20 is disposed wholly within refrigerating unit 10, and since refrigerating unit 10 is removable, contrary to the Examiner's assertion, Maynard neither discloses nor suggests an air cooling chamber that is an upward projected portion of either the

refrigerated compartment of chest type refrigerator cabinet 12 or refrigerated compartment 70 of front opening type refrigerator cabinet 14. (See Maynard, at FIGS. 1, 5, and 6, and col. 2, line 31-35, and col. 3, line 53 to col. 4, line 25).

Gidseg discloses a refrigerator 1 with a refrigeration module 10 installed on top of and in connection with insulated refrigeration cabinet 12. The refrigerating module is adjacent the food storage compartment (insulated refrigeration cabinet 12), and is separated from insulated refrigeration cabinet 12 by a wall having first and second openings therein, which define passageways interconnecting the two compartments. Thus, contrary to the Examiner's assertion, Gidseg neither discloses nor suggests that the portion of the refrigeration module 10 housing the evaporator coil 32 and evaporator fan 34 is not an upward projected portion of insulated refrigeration cabinet 12. (See Gidseg, at FIGS. 1-3, and col. 1, lines 47-65, and col. 5, line 41 to col. 6, line 47.

Applicants respectfully submit that none of Watanabe, Silva, Constantini 899, or Montes cures the defects of Constantini 902, Bauman, Maynard, and Gidseg, and thus, even the combination of Constantini 902, Bauman, Maynard, Gidseg, Watanabe, Silva, Constantini 899 and Montes fails to disclose every element of the claims, arranged as required by the claims.

Accordingly, Applicants respectfully submit that the Examiner has failed to provide evidence that the individual elements exist in the prior art, and thus, the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claims.

Applicants respectfully submit that independent claims 12, 25, and 50 patentably distinguish over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claims 4-9, 11- 23, and 26-47, which variously depend from independent claims 1, 12, or 25, should be allowable for at least the same reasons as claims 1, 12, and 25, as well as for the additional features recited therein.

CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview

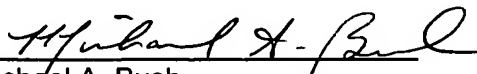
to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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